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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,966	03/24/2004	Gary A. Sigel	0019B	4098

112 7590 01/05/2006

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/807,966

Applicant(s)

SIGEL ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-9,11-13,15,17-22,38,39,41 and 55-67 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-9,11-13,15,17-22,38,39,41 and 55-67 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

1. The information disclosure statement filed March 24, 2004, has not been considered because it is labeled as being a part of Application Number 09/777,040 and not to 10/807,966. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Restriction

2. Newly amended claims 38 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: A freestanding coated film is a different invention than a surface covering or surface covering component.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 54-68 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

New Matter - 35 U.S.C. 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3-5, 7-9, 11-13, 15, 17-22, 38-39, 41 and 55-67 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1, 4-5, 8-9, 11, 38, 55, 59-61 and 63-65, the phrase, "thermoset top coat" is not supported by the specification. Additionally, in instant claim 38, the phrases, "freestanding coated film" and "freestanding film" are not supported by the specification. Applicant stated these limitations were supported at page 11, lines 7 to 11 and page 12, lines 6 to 11; however, Examiner could not find support in these sections of the specification.

Objection

5. Claims 39 and 41 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 39 and 41 are dependent on claim 38; however, claim 38 is directed to "a freestanding coated film" and claims 39 and 41 are directed to "the surface covering component," which are different inventions. Appropriate correction is requested.

Claim 64 is objected to for the phrase, "the first region distal the exposed surface." The term distal appears to be a typographical error. Correction or clarification is requested.

Claim Rejections – 35 USC § 102(b)

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidle et al. (U.S. 4,273,819).

Schmidle discloses a surface covering having surface portions with differential gloss effects, which are in registry with a pattern of printing ink compositions (column 1, lines 6-20 and column 18, lines 33-50) which comprises an ink composition having a predetermined pattern or design over a substrate, where the pattern or design comprises an inhibitor and a polymerization component and a polymerizable and cross-linkable wear layer is applied over the ink composition (column 1, line 66 through column 2, line 25). Schmidle further discloses the composition is relatively flat (comprises flattening agent) (column 3, lines 24-36 and column 9, lines 41-45) and accelerators and inhibitors (column 4, lines 20-25). The wear layer comprises various constituents and controlling agents which vary in ranges (column 6, lines 20-30) where

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the wear layer comprises thermoset polymeric materials derived from polymerization of materials, which further has high gloss and low gloss surface portions in perfect registry (column 18, lines 45-68). It is inherent that the gloss controlling agents have different concentrations for the high and low gloss portions. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. The Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miller Jr. et al. (U.S. 4,689,259) teaches a surface covering comprising a base (substrate) having on the upper surface a printed design and particles and a cured clear or translucent wear layer overlying the base, whereby the wear layer (top coat) surface in the areas containing particles and areas not containing particles will be of different gloss characteristics (column 2, lines 24-52). Miller Jr. further teaches the wear layer is UV curable (column 3, line 16 and 41) where color can

be applied to the substrate to provide designs along with a UV curable undercoat (column 3, lines 40-52). The reference discloses the glosses are controllable (column 3, lines 60-64). Miller Jr. does not teach a thermoset top coat layer.

Colyer (U.S. 4,456,643) teaches a floor covering having differential surface gloss comprising a substrate and a top layer (column 1, lines 34-50) and column 2, lines 25-44). Colyer does not teach the top coat being formed from a radiation curable composition. Additionally, Shirai et al (U.S. 5,717,222) teaches a substrate with a gloss control layer on top of it (abstract and Figure 1).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER

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